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**To:** COTCHETT, JOSEPH W. (reidl@sbcglobal.net)  
**Subject:** TRADEMARK APPLICATION NO. 78208591 - HALF MOON BAY - N/A  
**Sent:** 5/19/2005 8:24:04 PM  
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**Attachments:**


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**UNITED STATES PATENT AND TRADEMARK OFFICE**

**SERIAL NO:** 78/208591

**APPLICANT:** COTCHETT, JOSEPH W.

**CORRESPONDENT ADDRESS:**  
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**BEFORE THE  
TRADEMARK TRIAL  
AND APPEAL BOARD  
ON APPEAL**

**MARK:** HALF MOON BAY

**CORRESPONDENT'S REFERENCE/DOCKET NO:** N/A

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Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

**EXAMINING ATTORNEY'S APPEAL BRIEF**

Joseph W. Cotchett (Applicant) has appealed the examining attorney's final refusal to register the trademark HALF MOON BAY. Registration was refused pursuant to Section 2(e)(2) of the Trademark Act, 15 U.S.C. Section 1052(e)(2), on the basis that the mark is primarily geographically descriptive of the applicant's goods. The examining attorney respectfully requests that the refusal under Section 2(e)(2) be affirmed.

**STATEMENT OF FACTS**

The applicant applied to register the mark HALF MOON BAY for "wines" in an application filed on January 29, 2003. The examining attorney issued the refusal to register under Section 2(e)(2) because the proposed mark is primarily geographically descriptive on July 30, 2003 and required a signed declaration attesting to the facts set forth in the application. The applicant filed responses on October 1, 2003 and October 16, 2003 complying with the signed declaration requirement and arguing against the refusal. The examining attorney accepted the signed declaration and issued a final Office action on January 12, 2004 with respect to the 2(e)(2) refusal. The applicant submitted a request for reconsideration on July 9, 2004. The examining attorney denied the request for reconsideration on October 4, 2004. The applicant filed its notice of appeal and appeal brief on April 6, 2005.

## **ARGUMENT**

### **THE EXAMINING ATTORNEY OBJECTS TO THE APPLICANT'S REFERRAL TO AND SUBMISSION OF EVIDENCE AT APPEAL AS UNTIMELY AND UNSUPPORTED**

The examining attorney objects to the applicant's attempt to submit evidence at the appeal stage. The evidentiary record in an application should be complete prior to the filing of an *ex parte* appeal to the Trademark Trial and Appeal Board (Board). See 37 C.F.R. §2.142(d). See also *In re Juleigh Jeans Sportswear Inc.*, 24 USPQ2d 1694 (TTAB 1992); *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991); *In re Nationwide Industries Inc.*, 6 USPQ2d 1882 (TTAB 1988); *In re Bonni Keller Collections Ltd.*, 6 USPQ2d 1224 (TTAB 1987); *In re Gold's Gym Enterprises Inc.*, 3 USPQ2d 1716 (TTAB 1987); *In re International Environmental Corp.*, 230 USPQ 688 (TTAB 1986); *In re Mayer-Beaton Corp.*, 223 USPQ 1347 (TTAB 1984); *In re Compagnie Internationale Pour L'Informatique-Cie Honeywell Bull*, 223 USPQ 363 (TTAB 1984); *In re Carvel Corp.*, 223 USPQ 65 (TTAB 1984); *In re Jos. Schlitz Brewing Co.*, 223 USPQ 45 (TTAB 1983); *In re Best Western Family Steak House, Inc.*, 222 USPQ 827 (TTAB 1984); *In re Jeep Corp.*, 222 USPQ 333 (TTAB 1984); *In re Pierre Fabre S.A.*, 221 USPQ 1210 (TTAB 1984); *In re Development Dimensions International, Inc.*, 219 USPQ 161 (TTAB 1983); *In re Gagliardi Bros., Inc.*, 218 USPQ 181 (TTAB 1983); and *In re Royal Viking Line A/S*, 216 USPQ 795 (TTAB 1982). In this case, the applicant had the opportunity to submit evidence with its request for reconsideration in order to complete the evidentiary record for its application prior to appeal; however, he failed to do so.

Further, the applicant's mere reference to websites is also objectionable as unsupported because the applicant never made of record the information contained on said websites by downloading and attaching printouts of the websites for the record. Printouts of articles downloaded from the Internet are admissible as evidence of information available to the general

public, and of the way in which a term is being used by the public. TMEP §710.01(b). *See In re Total Quality Group Inc.*, 51 USPQ2d 1474 (TTAB 1999); *Raccioppi v. Apogee Inc.*, 47 USPQ2d 1368 (TTAB 1998). In this case, the applicant only refers to websites in his arguments against the refusal and never introduced the contents of these website by attaching them as evidence for the record.

Accordingly, the examining attorney respectfully requests that the Board disregard all references to websites mentioned within the applicant's appeal brief and all attachments to the applicant's appeal brief because this "evidence" was not submitted at the proper time, namely, prior to the appeal and because the website evidence is unsupported.

### **THE APPLICANT'S PROPOSED MARK "HALF MOON BAY" IS PRIMARILY GEOGRAPHICALLY DESCRIPTIVE OF THE APPLICANT'S GOODS**

The Trademark Act prohibits the registration of primarily geographically descriptive marks under Section 2(e)(2), 15 U.S.C. Section 1052(e)(2). To establish a *prima facie* case for refusal to register a mark under Trademark Action Section 2(e)(2), the examining attorney must establish the following: (1) the primary significance of the mark is geographic (see TMEP §1210.02(b)); (2) purchasers would be likely to make a goods/place or services/place association, *i.e.*, to think that the goods or services originate in the geographic place identified in the mark (see TMEP §1210.04); and (3) the mark identifies the geographic origin of the goods or services (see TMEP §1210.03). *See In re MCO Properties, Inc.*, 38 USPQ2d 1154 (TTAB 1995); *In re California Pizza Kitchen*, 10 USPQ2d 1704 (TTAB 1989). The examining attorney respectfully submits that she has established a *prima facie* case for this refusal and that the applicant has not rebutted the examining attorney's *prima facie* case with any credible evidence.

The applicant has applied to register the mark HALF MOON BAY. The primary significance of HALF MOON BAY is geographic. In the final Office action dated January 12, 2004, the examining attorney attached evidence from the global computer information network showing that the primary significance of HALF MOON BAY is the name of a geographic location. This evidence has been made part of the record. *See Merriam Webster's Geographical Dictionary* at page 465 (3<sup>rd</sup> Ed., 1997). *See also Ultralingua.net Dictionary* excerpt and the *Columbia Gazetteer of North America 2000* excerpt downloaded from the Internet. This evidence defines HALF MOON BAY as a city in California. A geographic location may be any term identifying a country, city, state, continent, locality, region, area or street. *See* TMEP §1210.02(a). Thus, the primary significance of the applicant's proposed mark HALF MOON BAY is geographic.

In its Appeal Brief, the applicant acknowledges that the mark has geographic significance given the fact that its winery is located in Half Moon Bay, California. The applicant contends that the mark is not primarily geographically

descriptive since “[t]o wine consumers across the United States, most of them unfamiliar with Northern California geography, the far more likely association is with two things: a half moon and a sheltered body of water.” See Applicant’s Brief p. 3. The applicant further contends that its mark “conjure[s] up, in the minds of wine drinkers, the image of enjoying Applicant’s product in the moonlight by the water.” *Id.* The applicant therefore concludes it is purely incidental that its mark shares the name with a specific location. The applicant’s argument is unpersuasive because it is not based on fact and because it lacks evidentiary support. The applicant has not introduced any evidence to support its claim that most wine consumers in the United States are unfamiliar with northern California geography and are likely to associate HALF MOON BAY with a half moon and a sheltered body of water. There is nothing in the record to refute the examining attorney’s *prima facie* case.

Purchasers are likely to believe the applicant’s goods will originate in that geographic location because the applicant is located in Half Moon Bay, California. The applicant has conceded this fact: “[t]he proposed marks do have geographic significance, since applicant’s winery is located in Half Moon Bay, California.” See Applicant’s Brief p. 3. Thus, there is a presumed goods/place association in this case. *In re J.T. Tobacconists*, 59 USPQ2d 1080 (TTAB 2001); *In re U.S. Cargo, Inc.*, 49 USPQ2d 1702 (TTAB 1998); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998); *In re Chalk’s International Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991); *In re California Pizza Kitchen*, 10 USPQ2d 1704 (TTAB 1989); *In re Handler Fenton Westerns, Inc.*, 214 USPQ 848 (TTAB 1982); TMEP §1210.04.

The applicant’s contention that the mark is not primarily geographically descriptive and further, that it is incidental that its mark shares the same name with a specific location since wine consumers would associate the mark not to a specific geographical location, but rather, to a half moon and a sheltered body of water as well as the image of enjoying Applicant’s product in the moonlight by the water, is unsupported by any evidence in the record. The fact that a term may have other meanings in other contexts does not necessarily negate the basis for refusal as long as the most prominent meaning or significance is geographic for the identified goods. *In re Opryland USA Inc.*, 1 USPQ2d 1409 (TTAB 1986); *In re Cookie Kitchen, Inc.*, 228 USPQ 873 (TTAB 1986); TMEP §1210.02(b) *et seq.* Additionally, to establish a goods/place association, it is not necessary to show that the place identified in the mark is well known or noted for the goods. TMEP Section 1210.04 (a); *In re Les Halles De Paris J.V.*, 334 F.3d 1371, 1374, 67 USPQ2d 1539, 1541 (Fed. Cir. 2003) (“[T]he goods-place association often requires little more than a showing that the consumer identifies the place as a known source of the product.”). See *In re Save Venice New York Inc.*, 259 F.3d 1346, 59 USPQ2d 1778 (Fed. Cir. 2001) (THE VENICE COLLECTION and design held primarily geographically deceptively misdescriptive of products that do not originate in Venice, Italy, where an atlas and a gazetteer showed that Venice was a large metropolitan area where fine art objects, glassware and decorative items had been made and sold for centuries, and a popular tourist destination); *In re Wada*, 194 F.3d 1297, 52 USPQ2d 1539 (Fed. Cir. 1999) (NEW YORK WAYS GALLERY held primarily geographically deceptively

misdescriptive where manufacturing listings and NEXIS excerpts showed that handbags and luggage are designed and manufactured in New York); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (evidence from a gazetteer and dictionary showing that tobacco is a crop produced and marketed in Durango, Mexico held sufficient to establish a *prima facie* goods/place association); *In re Broyhill Furniture Industries, Inc.*, 60 USPQ2d 1511 (TTAB 2001) (evidence that Tuscany, Italy is an important industrial center that produces a variety of products including furniture, and that several businesses advertise the sale of furniture from Tuscany on the Internet, held sufficient to establish a goods/place association between Tuscany and furniture, even though Tuscany is not famous for its furniture); *In re Boyd Gaming Corp.*, 57 USPQ2d 1944 (TTAB 2000) (HAVANA RESORT & CASINO and ROYAL HAVANA RESORT & CASINO held primarily geographically deceptively misdescriptive of wearing apparel, beauty products and perfume that do not come from Havana, Cuba, where the record showed that Havana produces a variety of goods, including clothing and cosmetic items); *In re Bacardi & Co. Ltd.*, 48 USPQ2d 1031 (TTAB 1997) (HAVANA SELECT, HAVANA CLASICO, OLD HAVANA, HAVANA PRIMO, and HAVANA CLIPPER all held primarily geographically deceptively misdescriptive of rum that does not originate in Havana, Cuba, where the evidence showed that Havana is a major city and rum is a significant product). Accordingly, the court held that "the registrability of a geographic mark may be measured against the public's association of that region with both its traditional goods and any related goods or services that the public is likely to believe originate there." *In re Save Venice New York Inc.*, 259 F.3d at 1355, 59 USPQ2d at 1784.

In this case, the applicant's arguments regarding the goods/place association are unpersuasive because the applicant admitted that "[T]he wine industry commonly uses geographic place names as trademarks." See Applicant's Brief p. 9. Since northern California is well-known as a wine-producing region and the applicant's wines originate from the city of Half Moon Bay in this region of California, it is more likely that the purchasing public will make a goods/place association because of the wine industry's common practice of using geographic place names as trademarks.

Finally, the applicant's argument that HALF MOON BAY is not primarily geographically descriptive since purchasers are not likely to associate its goods with a particular place because he claims there are several places known as Half Moon Bay is, again, unsupported by any evidence in the record. Rather than submit website excerpts, applicant merely referenced several website addresses. These references provide no basis for the examining attorney to consider how the term is used by the public, and thus, are insufficient to support applicant's argument. Even assuming *arguendo* that the applicant had properly made of record the content of the websites, the argument is inconsistent with well-settled case law. The fact that the mark may identify more than one geographic location does not necessarily detract from the term's primary geographic significance. TMEP Section 1210.02(b)(ii); *In re Loew's Theatres, Inc.*, 769 F.2d 764, 226 USPQ 865 (Fed. Cir. 1985) (DURANGO held primarily geographically deceptively misdescriptive of chewing tobacco not grown in Durango, Mexico, where the evidence of record showed that tobacco is a crop produced and marketed in that area, even though there is

more than one place named Durango); *In re Cambridge Digital Systems*, 1 USPQ2d 1659, 1662 (TTAB 1986) (CAMBRIDGE DIGITAL and design held primarily geographically descriptive of computer systems and parts thereof, where applicant's place of business is Cambridge, Massachusetts, even though there is more than one Cambridge). The three references properly of record all define HALF MOON BAY as one place, namely, the city in California where the applicant's goods originate. *See* attachments to final Office action dated January 12, 2004.

The proposed mark HALF MOON BAY does identify the geographic origin of the applicant's goods. The applicant has stated that the "[a]pplicant's winery is located in Half Moon Bay, California." *See* Applicant's Brief p. 3. In addition, the applicant's address of record, "700 Mill Street, HALF MOON BAY, California 94019" (emphasis added) identifies the geographic place named in the mark. *See* application filed on January 29, 2003.

### CONCLUSION

For the foregoing reasons, the examining attorney submits that HALF MOON BAY is primarily geographically descriptive. First, the primary significance of the proposed mark is geographic; second, purchasers are likely to believe that the applicant's goods originate in Half Moon Bay, California; and third, as the applicant admits, its goods originate in Half Moon Bay, California. The applicant has failed to provide any significant evidence to overcome the *prima facie* determination that the applicant's mark is primarily geographically descriptive based upon the adopted three-prong test. Accordingly, the refusal to register under Section 2(e)(2) should be affirmed.

Respectfully submitted,

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